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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,624	08/10/2000	Paul A. Firestone		5848
20311	7590	12/03/2003		
MUSERLIAN AND LUCAS AND MERCANTI, LLP 475 PARK AVENUE SOUTH NEW YORK, NY 10016				
			EXAMINER FRANKLIN, JAMARA ALZAIDA	
			ART UNIT 2876	PAPER NUMBER

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/635,624	FIRESTONE, PAUL A.	
	Examiner	Art Unit	
	Jamara A. Franklin	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11 and 13-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11 and 13-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgment is made of the receipt of the amendment received on 9/10/03. Claims 11 and 13-26 are currently pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 11 and 13-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urbish et al. (US 5,734,343) (hereinafter referred to as 'Urbish') in view of Slavin et al. (US 5,819,234) (hereinafter referred to as 'Slavin') and Leitner et al. (US 5,587,575) (hereinafter referred to as 'Leitner').

Urbish teaches a way to eliminate the tollbooth by eliminating the need for vehicles to slow or stop and deposit toll payments at the toll booth (col. 4, lines 46-58). A plurality of labels 15 are affixed in a variety of different locations on a vehicle 10 (col. 2, lines 45-51). The label contains information of a fixed nature, for example, the vehicle identification number, in a coded form. Bar codes have been found to be the label which is most machine readable, however, icons and alphanumeric text are also quite readable and may be used effectively. These various types may be used singly or in combination in the identification label (col. 3, lines 39-51). A detector 25 is used to pick up information (including identification number) about the

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vehicle 10 that is read from the label 15 as the vehicle and label pass under a light source 20.

The identification number is then used to assess tolls on the vehicle as it passes a certain location (col. 4, lines 10-29).

Urbish lacks the specific teaching of establishing an account with the identification code at a central agency and transferring data containing the identification code from the reader to the central agency.

Slavin teaches an account corresponding to a transponder 30 and unique tag number for charging toll. The account is established at a Customer Service Center 72 (col. 5, lines 53-60).

One of ordinary skill in the art would have readily recognized that establishing an account to be charged against would have been beneficial to the invention of Urbish since an account could have served as a established source for recording the charges made against the vehicle to which the account is associated. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Urbish with the aforementioned teachings of Slavin to help maintain a history of tolls collected.

Urbish/Slavin lack the teaching of moving readers.

Leitner teaches portable readers for use by police or traffic officials to scan a code that has been attached to a vehicle (col. 3, lines 18-20 and lines 60-62).

One of ordinary skill in the art would have readily recognized that moving the reader in conjunction to the code would have been beneficial to the invention of Urbish/Slavin for allowing the code to be read in a variety of conditions and situations including a case where the vehicle to which the code is affixed is located in an area not equipped for a fixed reader. Therefore, it would have been obvious, at the time the invention was made, to modify the

teachings of Urbish/Slavin with the moving reader as taught by Leitner. Furthermore, the notion that a device can be made movable or portable is an obvious improvement upon the device unless there are new and unexpected results.

Response to Arguments

3. Applicant's arguments filed 9/10/03 have been fully considered but they are not persuasive. The examiner maintains the rejection.

In response to applicant's argument that the examiner's conclusion of obviousness with regard to the combination of Urbish, Slavin, and Leitner is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to the argument that two separate functions are performed by two separate indicators and does not have Applicant's single vehicle identifier with a bar code containing the necessary information, the examiner submits that Urbish teaches a bar code label containing the vehicle identification number (col. 3, lines 39-51). Therefore, Applicant's single vehicle identifier is read upon by Urbish. The fact that a light source 20 and a detector 25 are jointly used to read the label does not differentiate the prior art from the claimed subject matter.

In response to applicant's arguments against the Urbish and Leitner references individually, one cannot show nonobviousness by attacking references individually where the

rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, support for the limitation citing a central agency issuing the vehicle bar code identifier is found in the Slavin reference.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is 703-305-0128. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

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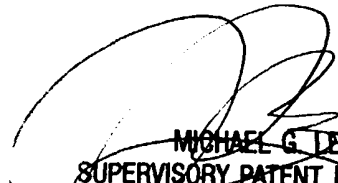
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Jamara A. Franklin
Examiner
Art Unit 2876

JAF
November 24, 2003



MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800